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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,749	06/26/2002	Michael Charles Sheppard	US57.0320-WO	5993

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Schlumberger Doll Research
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EXAMINER
FAYYAZ, NASHMIYA SAQIB

ART UNIT	PAPER NUMBER
2856	

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/049,749	Applicant(s) Sheppard et al
	Examiner Nashmiya Fayyaz	Art Unit 2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jan 4, 2002*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-14* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claims 4-5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, on the last line, "the surface" lacks antecedent basis.

In claim 5, "the casing surface" lacks antecedent basis.

In claim 9, it is unclear which "well fluids" are referred to since there is no prior reference to a "well".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-4, 9 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Aronstam et al - U.S. Patent #6,443,228.

As to claims 1-4, 9 and 13, Aronstam et al disclose a method and device employing flowable devices 63 in wellbores to communicate between surface and downhole instruments, the devices include memory devices and/or sensors for measurements where the fluid moves the device in the wellbore, see Figs. 1-4, notably Fig. 4 and column 4, lines 66 et seq.

As to claim 3, note Fig. 4 and column 8, lines 31-44 which describe a "container" and "selectively" releasing the devices 209.

As to claim 4, see Fig. 6 and "ceramic" capsule material 452 as in column 9, lines 57 et seq.

As to claim 9, note ballast 470.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aronstam et al.

As to claims 5-8 and 10-12, Aronstam et al. Disclose the flowable device as in Fig. 6 but lack specifics of sealing material, or spherical shape with two hemispheres joined by plastics. Firstly, the shape is considered to have been an obvious design choice and using seals would have been obvious as well to one of skill in the art at the time of the invention in order to prevent harsh fluids from entering the sensitive electronics. As to claims 10-11, the dimensions of devices are also considered to be obvious design choices obvious to one of ordinary skill in the art at the time of invention without performing undue experimentation. Further, encryption as in claim 12, is also an obvious design choice for protecting sensitive information.

Claims 1-4, 6, 8-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Bijleveld et al - U.S. Patent #6,241,028.

As to claims 1-4, 6, 8-11 and 13, Bijleveld et al disclose a method and system for measuring data in a fluid conduit including a downhole storage container 3 with a release mechanism 5 which releases sensing devices 4 which contain sensors 11/12/13 which transfer data to RAM on PC board 14, see Figs. 1-2 and column 4, lines 50 et seq.

As to claim 4, sensing device includes hard plastic shell 10.

As to claims 10-11, note the dimensions of column 5, lines 56-59 or column 7, lines 27-31 and Fig. 3 which depicts a different kind of shell.

Claims 5, 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bijleveld et al.

As to claims 5, 7 and 12, inclusion of sealing or separable elements for the sphere or data encryption are not disclosed by Bijleveld et al. However, each of these expediences are considered obvious design choices known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to have included the sealing to protect the sensitive electronics environment and to have used hemispheres for the sensing device shell to be able to insert the electronics or data encryption to protect sensitive information all as matters of design choice obvious to one of ordinary skill in the art as expediences known in the art.

Any inquiry concerning this communication should be directed to N. Fayyaz at telephone number (703) 305-4891.

N. Fayyaz/mm

11/25/02

DANIEL S. LARKIN
PRIMARY EXAMINER